

## REMARKS

Claims 1, 3-7, and 12-15 are pending in the present application. In this Amendment, Applicants have amended claims 1 and 7. Applicants are not conceding that the subject matter encompassed by claims 1 and 7, prior to this Amendment, are not patentable over the art cited by the Examiner. Claims 1 and 7 are amended in this Amendment solely to facilitate expeditious prosecution of the subject matter of the remaining claims. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claims 1 and 7, as presented prior to this Amendment, and any additional claims, in one or more continuing applications.

By this Amendment, claims 1 and 7 are amended to recite that providing limits for the tracing notifications further comprises limiting a number of retransmissions for which the tracing notifications operate and limiting the content of the tracing notifications. In limiting the number of retransmissions for which tracing notifications operate, a maximum number of retransmissions is set for the email message, an actual number of retransmissions of the email message is incremented each time the email message is forwarded from the original recipient to the one or more non-original recipients, responsive to the actual number of retransmissions being less than or equal to the maximum number of retransmissions, the email message is transmitted from the original recipient to the one or more non-original recipients, and responsive to the actual number of retransmissions being more than the maximum number of retransmissions, the email message is not transmitted from the original recipient to the one or more non-original recipients. In limiting the content of the tracing notifications, the content of the tracing notifications transmitted to the original sender is limited the content of the tracing notifications to only a name of the non-original recipient while excluding an e-mail address of the non-original recipient. Support for these amendments may be found in Applicants specification at least on page 7, line 19, to page 8, line 2. No new matter has been added by any of the above amendments to the claims. Reconsideration of the claims is respectfully requested in view of the following remarks.

**I. Rejection under 35 U.S.C. § 103(a), Claims 1, 3-7, and 12-15**

The Office Action rejects the subject matter of claims 1, 3-7, and 12-15 under 35 U.S.C. § 103(a) as being unpatentable over Barra et al. (U.S. Patent Publication No. 2002/0104026 A1) in view of Leonard et al. (U.S. Patent No. 6,721,784 B1). This rejection is respectfully traversed.

Amended claim 1 reads as follows:

1. A method for providing electronic mail (e-mail) services, said method comprising:
  - receiving from an original sender a request for tracing notifications, for an e-mail message;
  - in response to said request, creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications;
  - receiving at a computing device of the original sender said tracing notifications from one or more non-original recipients in response to said e-mail message being forwarded by an original recipient to at least one non-original recipient; and
  - providing limits for said tracing notifications, wherein said providing limits further comprises:**
    - limiting a number of retransmissions for which said tracing notifications operate, wherein limiting the number of retransmissions for which tracing notifications operate further comprises:**
      - setting a maximum number of retransmissions for the email message,**
      - incrementing an actual number of retransmissions of the email message each time the email message is forwarded from the original recipient to the one or more non-original recipients,**
      - responsive to the actual number of retransmissions being less than or equal to the maximum number of retransmissions, transmitting the email message from the original recipient to the one or more non-original recipients, and**
      - responsive to the actual number of retransmissions being more than the maximum number of retransmissions, refusing to transmit the email message from the original recipient to the one or more non-original recipients, and**
      - limiting the content of said tracing notifications, wherein limiting the content of the tracing notifications transmitted to the original sender limits the content of the tracing notifications to**

**only a name of the non-original recipient while excluding an e-mail address of the non-original recipient. (emphasis added)**

The Office Action bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Applicants respectfully submit that Abbott and Noland, taken alone or in combination, fail to teach or provide a technical reason for providing limits for the tracing notifications that limit a number of retransmissions for which the tracing notifications operate, where limiting the number of retransmissions comprises: setting a maximum number of retransmissions for the email message, incrementing an actual number of retransmissions of the email message each time the email message is forwarded from the original recipient to the one or more non-original recipients, responsive to the actual number of retransmissions being less than or equal to the maximum number of retransmissions, transmitting the email message from the original recipient to the one or more non-original recipients, and responsive to the actual number of retransmissions being more than the maximum number of retransmissions, refusing to transmit the email message from the original recipient to the one or more non-original recipients and limiting the content of the tracing notifications, where limiting the content of the tracing notifications transmitted to the original sender limits the content of the tracing notifications to only a name of the non-original recipient while excluding an e-mail address of the non-original recipient. Since the references fail to teach or suggest these features, the Office Action has failed to establish a *prima facie* case of obviousness, because the Office Action does not show where each and every claim limitation is taught or fairly suggested by the applied prior art.

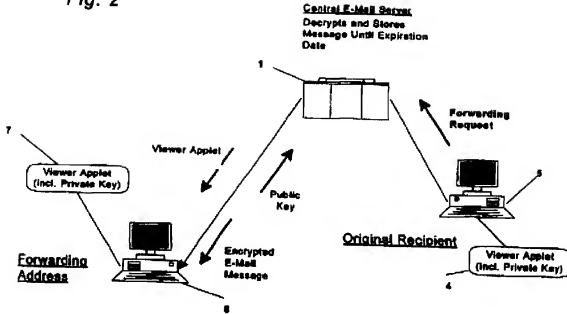
Barra is directed to providing specialized e-mail services to a sender, recipient or both, over a communications network. Barra establishes an online session with a computer at an e-mail center. A sender sends an e-mail packet including an e-mail message destined to a recipient together with a request for a specified verification of e-mail service to the e-mail center. This e-mail is then transmitted from the e-mail center the recipient and, when the recipient at least receives the e-mail, the e-mail center receives notification. In turn, the e-mail center provides at least the requested e-mail notification to the sender.

Leonard is directed to an electronic mail system that enables the originator of a message sent by electronic mail to select a date, time, or event at which the message and all incarnations of the message to self-destruct, regardless of the number and types of computers or software systems that may have interacted with the message, and/or to include processing and handling limitations.

Applicants respectfully submit that Barra and Leonard, taken alone or in combination, fail to teach or provide a technical reason for providing limits for the tracing notifications that limit a number of retransmissions for which the tracing notifications operate, where limiting the number of retransmissions comprises: setting a maximum number of retransmissions for the email message, incrementing an actual number of retransmissions of the email message each time the email message is forwarded from the original recipient to the one or more non-original recipients, responsive to the actual number of retransmissions being less than or equal to the maximum number of retransmissions, transmitting the email message from the original recipient to the one or more non-original recipients, and responsive to the actual number of retransmissions being more than the maximum number of retransmissions, refusing to transmit the email message from the original recipient to the one or more non-original recipients.

The Office Action acknowledges that Barra does not teach providing limits for the tracing notifications, where the limits consist of one or more limiting actions selected from a group consisting of: limiting the number of retransmissions for which the tracing notifications operate. However, the Office Action alleges that Leonard teaches this feature in Figure 2, column 10, lines 19-34 and column 15, lines 7-22, which are reproduced as follows:

**Fig. 2**



(Leonard, Figure 2)

It is an eleventh objective of the invention to provide an electronic mail system and method which tracks information concerning the usage and handling of the message by all recipients or any individual or group of recipients, including without limitation records or information concerning who received the message, who forwarded the message, who modified the message, the electronic mail addresses of all of these entities, and the dates and times of all transactions relating to forwarding and handling of the message.

It is a twelfth objective of the invention to provide records or information on the usage and handling of a message by all recipients of the message or by any defined sub-groups of recipients, and further provides for control or modification of the lifespan and/or handling limitations of messages received by members of any such sub-groups.

(Leonard, column 10, lines 19-34)

As illustrated in FIG. 2, this set-up enables forwarding of the message without surrendering control of the message. A forwarding request from the original recipient is handled in exactly the same manner as a request by the recipient to view the original message, i.e., by notification sent by the central server to the intended recipient of the forwarded message that an electronic mail message has been received, by downloading a viewer applet as necessary, and then by transmitting the message to the installed viewer applet 7 on the forwarded message recipient's computer 8. Although illustrated as a direct connection between

the server 1 and the computer 8, those skilled in the art will appreciate that server 1 and computer 8 could be connected to different nodes of the Internet, and that forwarding of the message may involve a second, local central electronic mail server (not shown).

(Leonard, column 15, lines 7-22)

In Figure 2, and the related description of column 15, lines 7-22, Leonard describes forwarding of a message from an original recipient. Leonard describes that a notification is sent by the central server to the intended recipient of the forwarded message that an electronic mail message has been received and that the intended recipient may retrieve the message using a viewer applet. In column 10, lines 19-34, Leonard describes tracking information concerning the usage and handling of the message by all recipients or any individual or group of recipients, including without limitation records or information concerning who received the message, who forwarded the message, who modified the message, the electronic mail addresses of all of these entities, and the dates and times of all transactions relating to forwarding and handling of the message. Leonard further describes provide records or information on the usage and handling of a message by all recipients of the message or by any defined sub-groups of recipients, and further provides for control or modification of the lifespan and/or handling limitations of messages received by members of any such sub-groups.

Nowhere, in any section of Leonard, is there a teaching or technical rational for providing limits for the tracing notifications by limiting a number of retransmissions for which the tracing notifications operate, where limiting the number of retransmissions comprises: setting a maximum number of retransmissions for the email message, incrementing an actual number of retransmissions of the email message each time the email message is forwarded from the original recipient to the one or more non-original recipients, responsive to the actual number of retransmissions being less than or equal to the maximum number of retransmissions, transmitting the email message from the original recipient to the one or more non-original recipients, and responsive to the actual number of retransmissions being more than the maximum number of retransmissions, refusing to transmit the email message from the original recipient to the one or more non-original recipients. While In Figure 5 Leonard describes button 340 that indicates that the email message may not be forwarded, one of ordinary skill in the art would recognize

this limitation as not allowing any forwarding and not limiting **a number of retransmissions** for which the tracing notifications operate. That is, Leonard either allows emails to be forwarded or completely prevents emails from being forwarded.

Furthermore, Leonard does not provide for limiting a number of retransmissions for which the tracing notifications operate by setting a maximum number of retransmissions for an email message, incrementing an actual number of retransmissions of the email message each time the email message is forwarded from the original recipient to the one or more non-original recipients, transmitting the email message from the original recipient to the one or more non-original recipients in response to the actual number of retransmissions being less than or equal to the maximum number of retransmissions, and refusing to transmit the email message from the original recipient to the one or more non-original recipients in response to the actual number of retransmissions being more than the maximum number of retransmissions. That is, nowhere, in any section of Leonard, is there a teaching or technical rational for setting a maximum number of retransmissions for an email message, keeping track of and incrementing an actual number of retransmissions of the email message, or determining if the actual number of retransmissions are less than, equal to, or more than the maximum number of retransmissions.

Additionally, Applicants respectfully submit that Barra and Leonard, taken alone or in combination, fail to teach or provide a technical reason for providing limits for the tracing notifications that limiting the content of the tracing notifications, where limiting the content of the tracing notifications transmitted to the original sender limits the content of the tracing notifications to only a name of the non-original recipient while excluding an e-mail address of the non-original recipient. The Office Action alleges that Leonard teaches limiting the content of the tracing notifications in Figure 2, column 10, lines 19-34 and column 15, lines 7-22, which are reproduced above. As discussed above, in Figure 2, and the related description of column 15, lines 7-22, Leonard describes forwarding of a message from an original recipient by sending a notification from a central server to the intended recipient of the forwarded message that an electronic mail message has been received and that the intended recipient may retrieve the message using a viewer applet. In column 10, lines 19-34, Leonard describes tracking information

concerning the usage and handling of the message by all recipients or any individual or group of recipients.

Nowhere, in any section of Leonard, is there a teaching or technical rational for provide a technical reason for providing limits for the tracing notifications that limiting the content of the tracing notifications, where limiting the content of the tracing notifications transmitted to the original sender limits the content of the tracing notifications to only a name of the non-original recipient while excluding an e-mail address of the non-original recipient. In fact, Leonard describes in Figure 17 and in column 22, line 51, to column 23, line 67, that the central server keeps a record of all transactions handled by the server, including forwarding of messages, allocation of control and access rights, and so forth. This record may include, without limitation, information concerning who received the message, who forwarded the message, who modified the message, **the electronic mail addresses of all of these entities**, and the dates and times of all transactions related to the users of the message. Leonard further describes that once records as defined above have been collected, the records can be provided to interested parties or subscribers for a variety of uses including the original sender as per Figure 17. That is, Leonard sends all information of every recipient to the original sender so the original sender may use the information for further emails.

Independent claim 7 recites similar features in its respective claim terminology. That is, claim 7 recites providing limits for the tracing notifications, where the providing limits further comprises: limiting a number of retransmissions for which the tracing notifications operate, where limiting the number of retransmissions for which tracing notifications operate further comprises: setting a maximum number of retransmissions for the email message, incrementing an actual number of retransmissions of the email message each time the email message is forwarded from the original recipient to the one or more non-original recipients, responsive to the actual number of retransmissions being less than or equal to the maximum number of retransmissions, transmitting the email message from the original recipient to the one or more non-original recipients, and responsive to the actual number of retransmissions being more than the maximum number of retransmissions, refusing to transmit the email message from the original recipient to the one or more non-original recipients, and limiting the content of the



tracing notifications, where limiting the content of the tracing notifications transmitted to the original sender limits the content of the tracing notifications to only a name of the non-original recipient while excluding an e-mail address of the non-original recipient.

Furthermore, no suggestion is present in any of the references to modify the references to include such a feature. That is, there is no teaching or suggestion in Barra and Leonard, taken alone or in combination, that a problem exists for which providing limits for the tracing notifications, where the providing limits further comprises: limiting a number of retransmissions for which the tracing notifications operate, where limiting the number of retransmissions for which tracing notifications operate further comprises: setting a maximum number of retransmissions for the email message, incrementing an actual number of retransmissions of the email message each time the email message is forwarded from the original recipient to the one or more non-original recipients, responsive to the actual number of retransmissions being less than or equal to the maximum number of retransmissions, transmitting the email message from the original recipient to the one or more non-original recipients, and responsive to the actual number of retransmissions being more than the maximum number of retransmissions, refusing to transmit the email message from the original recipient to the one or more non-original recipients, and limiting the content of the tracing notifications, where limiting the content of the tracing notifications transmitted to the original sender limits the content of the tracing notifications to only a name of the non-original recipient while excluding an e-mail address of the non-original recipient, is a solution. To the contrary, Barra merely returns a receipt to a sender when an email is delivered and/or read by a recipient and Leonard either allows emails to be forwarded or completely prevents emails from being forwarded at all and sends all information of every recipient to the original sender so the original sender may use the information for further emails.

Moreover, neither reference teaches or suggests the desirability of incorporating the subject matter of the other reference. That is, there is no motivation offered in either reference for the alleged combination. The Examiner alleges that the motivation would be “in order to facilitate forwarding tracing notification from non-intended recipient to the original sender and limiting the tracing notification based on a number of factors.” The present invention provides for limiting tracing notifications by limiting a number of

retransmissions for which the tracing notifications operate, where limiting the number of retransmissions for which tracing notifications operate further comprises: setting a maximum number of retransmissions for the email message, incrementing an actual number of retransmissions of the email message each time the email message is forwarded from the original recipient to the one or more non-original recipients, responsive to the actual number of retransmissions being less than or equal to the maximum number of retransmissions, transmitting the email message from the original recipient to the one or more non-original recipients, and responsive to the actual number of retransmissions being more than the maximum number of retransmissions, refusing to transmit the email message from the original recipient to the one or more non-original recipients, and limiting the content of the tracing notifications, where limiting the content of the tracing notifications transmitted to the original sender limits the content of the tracing notifications to only a name of the non-original recipient while excluding an e-mail address of the non-original recipient. As discussed above, Barra merely returns a receipt to a sender when an email is delivered and/or read by a recipient and Leonard either allows emails to be forwarded or completely prevents emails from being forwarded at all and sends all information of every recipient to the original sender so the original sender may use the information for further emails. Neither reference teaches or suggests providing limits for the tracing notifications that comprise limiting a number of retransmissions for which the tracing notifications operate and limiting the content of the tracing notifications. Thus, the only teaching or suggestion to even attempt the alleged combination is based on a prior knowledge of Applicants claimed invention thereby constituting impermissible hindsight reconstruction using Applicants' own disclosure as a guide.

One of ordinary skill in the art, being presented only with Barra and Leonard, and without having a prior knowledge of Applicants' claimed invention, would not have found it obvious to combine and modify Barra and Leonard to arrive at Applicants' claimed invention, as recited in independent claims 1 and 7. To the contrary, even if one were somehow motivated to combine Barra and Leonard, and it were somehow possible to combine the systems, the result would not be the invention, as recited in claims 1 and 7. The resulting system would merely return a receipt to a sender when an email is

delivered and/or read by any recipient, allow emails to be forwarded or completely prevents emails from being forwarded at all, and sends all information of every recipient to the original sender so the original sender may use the information for further emails. The resulting system would still fail to provide limits for tracing notifications, that comprise: limiting a number of retransmissions for which the tracing notifications operate, where limiting the number of retransmissions for which tracing notifications operate further comprises: setting a maximum number of retransmissions for the email message, incrementing an actual number of retransmissions of the email message each time the email message is forwarded from the original recipient to the one or more non-original recipients, responsive to the actual number of retransmissions being less than or equal to the maximum number of retransmissions, transmitting the email message from the original recipient to the one or more non-original recipients, and responsive to the actual number of retransmissions being more than the maximum number of retransmissions, refusing to transmit the email message from the original recipient to the one or more non-original recipients, and limiting the content of the tracing notifications, where limiting the content of the tracing notifications transmitted to the original sender limits the content of the tracing notifications to only a name of the non-original recipient while excluding an e-mail address of the non-original recipient.

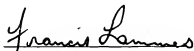
In view of the above, Applicants respectfully submit that Barra and Leonard, taken alone or in combination, fail to teach or suggest the features of claims 1 and 7. At least by virtue of their dependency on independent claims 1 and 7, the features of dependent claims 3-6 and 12-15 are not taught or suggested by Barra and Leonard, whether taken individually or in combination. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 3-7, and 12-15 under 35 U.S.C. § 103(a).

## II. Conclusion

It is respectfully urged that the subject application is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

DATE: December 2, 2008



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